

REMARKS

The Examiner rejected: 1) Claim 4 under 35 U.S.C. § 112 2nd ¶ as indefinite; 2) Claims 1 and 3 as obvious under 35 U.S.C. § 103(a) over Hyllander et al. (PCT No. WO 99/12365) in view of Fuentes (U.S. Patent No. 5,960,340); 3) Claim 2, 5 and 6 as obvious over Hyllander in view of Fuentes and further in view of Moon (U.S. Patent No. 6,075,992); and 4) Claim 4 as obvious over Hyllander in view of Fuentes and further in view of Wiedeman (U.S. Patent No. 5,448,623); and 5) Claim 7 as obvious over Hyllander in view of Fuentes, and further in view of Moon and further in view of Wiederman. Applicants traverse the rejections and respectfully request reconsideration.

The Examiner also objected to the Abstract and to the disclosure because of several informalities. Applicants have replaced the Abstract and amended the specification in manners suggested by the Examiner to overcome the objections. Applicants respectfully submit that the Examiner's objections are now moot.

15 **I. § 112 Rejections**

The Examiner rejected Claim 4 as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner noted that "a gateway locator to locate a user gateway closest to the user telephone number" is unclear because a gateway can't be close to a telephone number. Applicants have amended claim 4 and respectfully submit that the Examiner's § 112 rejection is now moot.

II. § 103(a) Obviousness Rejections

The Examiner rejected all of the claims as obvious under § 103(a) over various combinations of Hyllander, Fuentes, Moon and Wiederman. Applicants respectfully submit that the Examiner has not made a prima facie case of obviousness. One of ordinary skill in the art would not have been motivated to combine Hyllander and Fuentes in the manner asserted by the Examiner to

arrive at the invention as claimed in claims 1 and 3. In addition, because all of the claims are based on a combination of Hyllander and Fuentes, one of ordinary skill in the art would also not have combined Hyllander and Fuentes, to arrive at the invention as claimed in claims 2, and 4-7. The Examiner has therefore based
5 all of the rejections on improper hindsight analysis.

To meet the burden of prima facie obviousness, the Examiner must put forth evidence to fulfill three criteria: 1) there must be a suggestion or motivation to modify the reference or combine reference teachings, 2) there must be a reasonable likelihood of success of the modification or combination, and 3) the
10 prior art references must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In this case, the Examiner has failed to show any suggestion or motivation to make the asserted combination. In addition, the Examiner has also failed to show any reasonable likelihood of success in making the asserted combination.

15 Neither Hyllander nor Fuentes contains any suggestion or motivation to make the combination asserted by the Examiner. Hyllander is directed to a communication system that is adapted to enable a Global System for Mobile (GSM) Communication Network subscriber to make an Internet telephone call to an Internet user. Hyllander uses a "short message service" (SMS) to transfer
20 address information for the Internet user to an Internet server. See Hyllander, pg. 1, lines 3-9. A mobile station subscriber uses the SMS to transfer an Internet address for an Internet connected computer terminal of the Internet user, and a specific identity for the mobile station subscriber, such as for example, the telephone number for the mobile station subscriber. *Id.* at pg. 4, lines 6-15. The
25 SMS is therefore used by a GSM subscriber to establish a telephone connection to an Internet-connected user. *Id.* at pg. 3, lines 13-15.

Fuentes teaches an automatic registration system that combines a mobile station registration step with a user's registration to a universal telephone number service. See Fuentes col. 1, lines 6-65. When a mobile station performs a

registration and authentication step to register with a cellular system, the system sends signaling messages to the universal telephone number service with the mobile station telephone number as the "universal number." Col. 1, line 53 to col. 2, line 40. Fuentes advantageously teaches combining the registration/authentication step of the mobile station with the registration of the mobile station's telephone number on the universal telephone number service. Once the user registers the mobile station (e.g. on power-up or entry on the cell-site), the user becomes registered on the universal telephone number service. The automatic registration spared the user from having to register the universal telephone number every time the user changed location. See Fuentes, col. 1, lines 31-50.

In rejecting the claims, the Examiner asserted that:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hyllander's personal information device to request a change of the user profile telephone number in a telephony control server, as taught by Fuentes. One of ordinary skill in the art would have been led to make this modification because wireless mobile devices often change locations and require registration with the local telephony control server in order to place and receive calls using the desired telephone number as taught by Fuentes.

Detailed Action, pg. 5. Applicants respectfully submit that the Examiner has not cited to any teaching or suggestion in either reference to modify Hyllander to request a change of the user profile telephone number as taught by Fuentes. Applicants respectfully submit that such a teaching or suggestion is impossible because Hyllander cannot be modified in the manner suggested by the Examiner with the teachings of Fuentes without destroying the intended function of either Hyllander or Fuentes.

Fuentes teaches registration of the universal telephone number service upon registration of the mobile station to preclude the need to make any further

-6-

registrations. Hyllander on the other hand teaches using the SMS to transfer information to connect to an Internet user. Applicants respectfully submit that if Fuentes teaches communicating connection information to the universal telephone number on *registration of the mobile station*. Once the mobile station registers in Fuentes, the universal telephone number registration has taken place. Any further SMS functions, which may only be performed after the mobile station registers with the cell-site, would destroy the intended function of Fuentes...which is to preclude the need for further registrations to the universal telephone number service.

- 10 Applicants respectfully submit that Hyllander cannot be modified with Fuentes in the manner suggested by the Examiner without destroying the intended function of either reference. Applicants respectfully submit that all of claims 1-7 are allowable. Favorable reconsideration is respectfully requested.

CONCLUSION

Applicants therefore respectfully submit that all pending claims 1-7 are allowable and request that the rejections to those claims be withdrawn. If any questions or issues remain, the Examiner is invited to contact the undersigned attorney, Enrique Perez, at his direct dial number (312) 913-2104.

Respectfully submitted,

McDONNELL BOEHNEN
HULBERT & BERGHOFF

Date: 11-4-02

By: 
Enrique Perez
Registration No. 43,583

APPENDIX A**A. Marked-Up Version of Amendments to the Specification**
At page 6, at the paragraph starting on line 17:

5 The present invention addresses the above needs by providing a system
in a data network telephony system, such as for example, the Internet, that uses
a wireless personal information device (PID) to control the telephony system. A
user may configure his or her telephone service by connecting to a telephony
control server using the wireless PID. The wireless PID connection to the
10 telephony control server may provide a user with the power to control the
behavior of the telephone system to meet the user's needs.

At page 7, amend the first full paragraph to read as follows:

In a first aspect of the present invention, a personal information device
(PID) is provided for controlling telephone service. The PID includes a user
15 interface having a display and a user input device. A user profile includes a
telephone number entered by a user. A communications function in the PID
establishes a data communications channel over a wireless network to a
telephony control server. The telephony control server contains the user's
telephony account. An account update function in the PID sends a message
20 over the data communication channel to the telephony control server. The
message contains the user profile telephone number and a request to set the
user's telephony account telephone number to the user profile telephone
number.

25 B. Claims Presently Pending, Including Marked-Up Version of Amended Claims

1. A personal information device (PID) for controlling telephone service
comprising:

a user interface comprising a display and a user input device;

5 a user profile having a telephone number entered by a user;

a communications function to establish a data communications channel over a wireless network to a telephony control server, the telephony control server containing the user's telephony account; and

10 an account update function to send a message over the data communication channel to the telephony control server, the message containing the user profile telephone number and a request to set the user's telephony account telephone number to the user profile telephone number.

2. The PID of Claim 1 further comprising:

5 a contacts application operable to display a plurality of contact entries, each entry comprising a contact telephone number, the contacts application operable to send the contact telephone number over the data communications channel to the telephony control server with a message to call the contact telephone number.

3. A telephony control server comprising:

5 a network interface operable to provide data connectivity with a user accessible via a wireless network;
an accounts program to access a plurality of user accounts, the accounts program operable to receive a message to set a user telephone number, each user account containing a telephone number entry, the accounts program being operable to set the telephone number entry in response to the message;

10 a connection signaling function to receive a call message
from the user and to establish a telephone connection between the
user telephone number and a callee telephone number contained in
the call message; and

15 the connection signaling function operable to initiate a
telephone call having at least a portion of the telephone call
connected via the data network.

4. The telephony control server of Claim 3 further comprising:

5 a gateway locator to locate a user gateway closest to the
user telephone (number) and to locate a callee gateway closest to
the callee telephone (number); wherein the connection signaling
function initiates the portion of the call connected via the data
network between the user gateway and the callee gateway.

5. A method for modifying a user telephone account having a telephone
number entry using a wireless personal information device (PID) connected over
a data network, the method comprising the steps of:

5 updating a user profile in the wireless PID to a user
telephone number; and

10 sending a request to set the user telephone account to the
user telephone number over a data communications channel to a
telephony control server wherein the telephony control server
updates the user telephone number entry to the user telephone
number.

1 6. A method for initiating a data network telephone call using a wireless PID
2 with a display comprising the steps of:

3 starting a contacts application to display a plurality of contact
4 entries;
5 selecting one of the contact entries identifying a callee;
6 initiating a data communications channel to a telephony
7 control server having a user telephone number;
8 sending a message to call the callee;
9 connecting a telephone call to the user; and
10 connecting the telephone call to the callee.

1 7. The method of Claim 6 wherein the step of connecting the telephone call
2 to the callee includes the steps of locating a callee gateway closest to the user
3 telephone number and sending a signal to call the callee by dialing via a callee's
4 central office.